

## **REMARKS**

Reconsideration of this application, as amended, is respectfully requested.

### **A. Status of the Claims**

Claims 1-9, 13, 19-42, and 46 are canceled without prejudice or disclaimer. Claims 10 and 43 are amended to further clarify the invention. Applicants thank the Examiner for indicating allowable subject matter of claims 13 and 46 if rewritten in independent form. The subject matter of canceled claims 13 and 46 is now incorporated in Claims 10 and 43. Thus, the amendments do not constitute new matter. Claims 15, 16, 48, and 49 are withdrawn by the Examiner as allegedly being drawn to a non-elected invention. Claims 10-14, 17-18, 43-47, and 50 are currently under examination for their merits.

### **B. Claims Withdrawn by the Examiner**

The Examiner withdrew claims 15-16, and 48-49 for allegedly not reading on the elected species for the recognition probe. Applicants provisionally elected protein as the species for the recognition probe on May 19, 2006. Claims 15 and 48 are directed to a nanoparticle or a kit comprising a nanoparticle wherein the recognition probe of the nanoparticle comprises a lipid bound protein, which further comprises a G-protein coupled receptor. Claims 16 and 49 are directed to a nanoparticle or a kit comprising a nanoparticle wherein the recognition probe of the nanoparticle comprises an antibody, an antigen, a receptor, or a ligand. Applicants submit that the term "protein" could encompass a lipid bound protein, a G-protein coupled receptor, an antibody, an antigen, a receptor, and a ligand. Thus, claims 15-16, and 48-49 do read on the elected species protein. Accordingly, Applicants respectfully request claims 15-16, and 48-49 reinstated and examined on their merits.

### **C. Information Disclosure Statement**

Applicants submitted the Sixth Supplemental Information Disclosure Statement listing four references on August 6, 2004. However, the PTO Form 1449 submitted with the Sixth Supplemental Information Disclosure Statement was not initialized by the Examiner and returned to the Applicants. Applicants herewith submit a copy of a PTO date stamped return receipt postcard, which acknowledged receipt of the IDS, PTO Form 1449, and references, for Examiner's review. Applicants resubmit a copy of the Sixth Supplemental Information Disclosure Statement, references cited therein, and PTO Form 1449 under a separate cover.

The Examiner is requested to execute PTO Form 1449 and return a copy to the Applicants in accordance with MPEP §§ 609 and 707.05(b).

**D. Claim Rejections under 35 U.S.C. 102(e)**

Claims 10-12, 14, 17, 18, 43-45, 47 and 50 stand rejected under 35 U.S.C. 102(e) as allegedly being anticipated by Park et al. (US 2003/0207296) ("Park"). Specifically, the Examiner asserted that Park discloses a nanoparticle having a plurality of polyanionic polymer conjugate attached thereto. Applicants respectfully traverse the rejection and submit that Park is not anticipatory prior art because it does not teach every element of amended claims 10 and 43.

The Federal Circuit has stated that for prior art to anticipate under section 102, every element of the claimed invention must be identically disclosed in a single reference. *Corning Glass Works v. Sumitomo Electric*, 9 U.S.P.Q.2d 1962, 1965 (Fed. Cir. 1989). The exclusion of a claimed element, no matter how insubstantial or obvious, from a reference is enough to negate anticipation. *Connell v. Sears, Roebuck & Co.*, 220 U.S.P.Q 193, 198 (Fed. Cir. 1983).

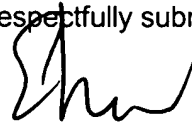
The amended claim 10 recites a nanoparticle having a plurality of polyanionic polymer conjugates attached thereto, wherein the functional group for attaching a recognition probe to the polyanionic polymer comprises a carboxylic acid or an amino group. Applicants submit that Park does not teach or suggest a nanoparticle having a plurality of polyanionic polymer conjugates attached thereto, wherein the functional group for attaching a recognition probe to the polyanionic polymer comprises a carboxylic acid or an amino group. Furthermore, Park does not teach or suggest a kit comprising a nanoparticle having a plurality of polyanionic polymer conjugates attached thereto, wherein the functional group for attaching a recognition probe to the polyanionic polymer comprises a carboxylic acid or an amino group. Thus, Park does not anticipate the subject matter of pending claims. Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection under 35 U.S.C. 102(e).

**E. Conclusion**

The Applicants believe that the application is ready for allowance. A favorable decision is earnestly solicited. If the Examiner has any questions, she is invited to call the undersigned attorney at 312-913-2126.

Dated: Jan. 18, 2007

Respectfully submitted,



---

Emily Miao  
Registration No. 35,285

McDonnell Boehnen Hulbert & Berghoff LLP  
300 South Wacker Drive  
Chicago, Illinois 60606  
Telephone: (312) 913-0001  
Facsimile: (312) 913-0002